

## **2. Claim Rejections under 35 U.S.C. §103**

Claims 77-90 were rejected under 35 U.S.C. §103(a) as being unpatentable over Janisiewicz et al. (US 5,040,291) in view of Livengood et al. (US 5,805, 421) and in further view of Harada (US 4,675,993) and Farnworth et al. (US 6,492,187).

The Office Action provides that "Farnworth discloses an optical fiducial marker detector (col. 9, lines 25-39) thereby determining a component's exact position".

Applicant respectfully submits that Farnworth et al. should be disqualified as a prior art reference under 35 U.S.C. 103(c) which provides:

§103(c). Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject application is a division of application Ser. No. 08/915,862, filed August 21, 1997, now Patent No. 6,085,407, which is assigned to Micron Technology Inc. The assignment was recorded in August 21, 1997, on Reel 8751, Frame 0578.

Farnworth et al., has an issue date of Dec. 10, 2002. Therefore, Farnworth et al. would qualify as prior art only under §102(e). Farnworth et al. ultimately claims priority by division (without intervening continuation-in-part applications) from application Ser. No. 08/893,398 filed August 7, 1996, now Patent No. 5,894,218, also assigned to Micron Technology, Inc. The assignment was recorded with the USPTO on October 7, 1996. See enclosed Dialog search record. Therefore, Micron Technology Inc. owned the subject matter of Farnworth et al. at the time of the claimed invention. Accordingly, all the requirements of §103(c) are satisfied and Farnworth et al. should not be used to preclude the patentability of the subject application.

With Farnworth et al. disqualified, a prima facie case of obviousness for claims 77-90 has not been made.

For the record, Applicant reasserts its earlier position that Livengood and Harada are not combinable without destroying the functionality of their respective devices for the reasons provided in the Response to Office Action dated October 1, 2002.

### **3. Conclusion**

Applicant submits that all of the pending claims are in condition for allowance. Accordingly, reconsideration and passage to allowance of the subject application at an early date are earnestly solicited. If the undersigned can be of assistance in advancing the subject application to allowance, the Examiner may contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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